

# **TERMINAL DISCLAIMER TO OBVIATE A DOUBLE PATENTING REJECTION OVER A PRIOR PATENT**

Docket Number (Optional)

301-396

# **RECEIVED**

SEP 02 2004

Technology Center 2600

In re Application of: Sainton et. al.

Application No.: 09/670,696

Filed: September 28, 2000

For: ADAPTIVE OMNI-MODAL RADIO APPARATUS AND METHODS

The owner\*, MLR, LLC, of 100 percent interest in the instant application hereby disclaims, except as provided below, the terminal part of the statutory term of any patent granted on the instant application, which would extend beyond the expiration date of the full statutory term defined in 35 U.S.C. 154 and 173, as presently shortened by any terminal disclaimer, of prior Patent No. 6,134,453. The owner hereby agrees that any patent so granted on the instant application shall be enforceable only for and during such period that it and the prior patent are commonly owned. This agreement runs with any patent granted on the instant application and is binding upon the grantee, its successors or assigns.

In making the above disclaimer, the owner does not disclaim the terminal part of any patent granted on the instant application that would extend to the expiration date of the full statutory term as defined in 35 U.S.C. 154 and 173 of the prior patent, as presently shortened by any terminal disclaimer, in the event that it later: expires for failure to pay a maintenance fee, is held unenforceable, is found invalid by a court of competent jurisdiction, is statutorily disclaimed in whole or terminally disclaimed under 37 CFR 1.321, has all claims canceled by a reexamination certificate, is reissued, or is in any manner terminated prior to the expiration of its full statutory term as presently shortened by any terminal disclaimer.

Check either box 1 or 2 below, if appropriate.

1. ☐ For submissions on behalf of an organization (e.g., corporation, partnership, university, government agency, etc.), the undersigned is empowered to act on behalf of the organization.

I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.

2. ☒ The undersigned is an attorney or agent of record.

*Charles M. Leedom, Jr.* 8-26-04  
Signature Date

Charles M. Leedom, Jr.

Typed or printed name

703 241 0165

Telephone Number

- ☒ Terminal disclaimer fee under 37 CFR 1.20(d) included.

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\*Statement under 37 CFR 3.73(b) is required if terminal disclaimer is signed by the assignee (owner).  
Form PTO/SB/96 may be used for making this certification. See MPEP § 324.

This collection of information is required by 37 CFR 1.321. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.14. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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## EXHIBIT C

Spectrum Information Technologies, Inc. and Spectrum Cellular Corporation v. Data Race, Inc., Civil Action 3:92-CV-2187-H, U.S. District Court for the Northern District of Texas, Dallas Division, Consent Judgment of infringement and validity in Spectrum's favor

Data Race, Inc. v. Spectrum Information Technologies, Inc., U.S. District Court for the Western District of Texas, San Antonio SA92CA0996, dismissed in favor of Dallas litigation

Spectrum Information Technologies, Inc. v. Microcom, Inc., Civil Action No. 3:92-CV 2357, U.S. District Court for the Northern District of Texas, Dallas Division, Consent Judgment of infringement and validity in Spectrum's favor

Spectrum Information Technologies, Inc. v. Motorola, Inc., Civil Action No. 95-U-234-NE, U.S. District Court for the Northern District of Alabama, dismissed as a result of Agreement and cross license between Spectrum and Motorola

O'Sullivan (Spectrum) v. Morris (ITC), Interference No. 103,466, US PTO Board of Patent Appeals and Interferences, priority awarded to O'Sullivan (Spectrum)

Nagel et al. (Compaq) v. Sainton (Spectrum), Interference No. 103,916, US PTO Board of Patent Appeals and Interferences, U.S. Patent and Trademark Office, priority awarded to Sainton (Spectrum)

Uddentfeldt (Ericsson) v. Sainton et al. (MLR, LLC), Interference No. 105,076, US PTO Board of Patent Appeals and Interferences, dismissed upon entry of adverse judgment against Uddentfeldt (Ericsson) awarding priority to Sainton et al. (MLR, LLC)

MLR v Nokia Corporation, Telefonaktiebolaget LM Ericsson, US Robotics, Sony-Ericsson Mobile Communications AB, Handspring, Toshiba, Samsung, Sierra Wireless, Kyocera (Japan), Civil Action No. 02 C 2898, U.S. District Court for the Northern District of Illinois, Eastern Division, dismissed as a result of all defendants agreeing to take licenses under MLR's patents except Kyocera (Japan)\*.

\*Kyocera (Japan) was dismissed for lack of jurisdiction without prejudice to MLR's right to bring suit against Kyocera (US).

Kyocera (USA) v. MLR, LLC, Civil Action No. 02 CV 0527 W (CGA), U.S. District Court for the Southern District of California, dismissed upon MLR's motion for lack of jurisdiction over MLR in California

Nokia Corp. et al. v. MLR, LLC, Civil Action No. 3:02cv02356K, U.S. District Court for the Northern District of Texas, Dallas Division, dismissed as a result of Nokia's Agreement to take a license under MLR's patents

Handspring, Inc. v. MLR, LLC, Civil Action No. 03-CV-00325 SBA, U.S. District Court for the Northern District of California, Oakland Division, dismissed as a result of Agreement by Handspring to take a license under MLR's patents

In Re MLR, LLC, Patent Litigation, The Judicial Panel On Multidistrict Litigation, Docket No. 1525, authorized coordinated and consolidated pretrial proceedings in the US District Court for the Northern District of Illinois.

**EXHIBIT A**

**MLR, LLC**

Summary of U.S. Patent Rights as of January 9, 2004

**Issued U.S. Patents**

1. U.S. Patent RE 34,034 (Reissue of 4,697,281)
2. U.S. Patent RE 37,141 (Divisional Reissue of 4,697,281)
3. U.S. Patent RE 38,127 (Reissue of 4,972,457 includes claims copied from ITC - U.S. Patent No. 4,901,197)
4. U.S. Patent No. 5,127,041
5. U.S. Patent No. 5,249,218
6. U.S. Patent No. 5,353,334
7. U.S. Patent No. 5,367,563
8. U.S. Patent No. 5,640,444
9. U.S. Patent No. 5,761,621
10. U.S. Patent No. 5,854,985
11. U.S. Patent No. 6,134,453
12. U.S. Patent No. 6,295,460 (assigned to MLR by Compaq in settlement of Interference No. 103,916)

**Pending U.S. Applications with Allowed Claims**

13. U.S. App. Ser. No. 09/392,676 (Reissue of U.S. Patent No. 5,761,621 includes claims copied from Ericsson - U.S. Patent No. 5,805,633)
14. U.S. App. Ser. No. 10/141,880 (Divisional Reissue of U.S. Patent No. 4,972,457)
15. U.S. App. Ser. No. 09/813,165 (original application- corresponding PCT claims found to have met international patentability standards as indicated in US PCT Examination Report)
16. U.S. App. Ser. No. 09/835,464 (Second Divisional Reissue of U.S. Patent 4,697,281)

**Other Pending U.S Applications**

17. U.S. Appl Ser. No. 09/953,211 (Divisional of U.S. Patent No. 6,295,460)

18. U.S. App. Ser. No. 09/670,696 (Second Divisional of U.S. Patent No. 5,854,985)
19. U.S. App. Ser. No. 10/737,670 (Divisional Reissue of U.S. Patent No. 5,761,621)

**Third Party Patents From Which Claims Have Been Copied**

20. ITC - U.S. Patent No. 4,901,197 (Interference No. 103,466 involving MLR's Re 38,127; priority awarded to MLR with respect to all '197 claims)
21. Ericsson - U.S. Patent No. 5,805,633 (Claims 1, 3, 5, 8-9, 12-13, 16-18, 20-22, 29, 31-32, and 35 have been copied into and allowed in MLR U.S. App. Ser. No. 09/392,676 pursuant to favorable resolution of Interference No. 105,076)